

A
Patent
242/026

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 242/026
First Named Inventor: Neil H. Bander
Prior Application Information:
Prior docket 242/023
Examiner: Y. Eyler
Art. Unit: 1642

BOX PATENT APPLICATION
Assistant Commissioner for Patents
Washington, D. C. 20231

FILING UNDER 37 CFR § 1.53(B)

This is a request for filing for a

☐ continuation ☒ divisional ☐ continuation-in-part (CIP)

application under 37 CFR § 1.53(b) of pending prior application Serial
No. 08/838,682 filed on April 9, 1997, by:

Neil H. Bander

entitled: TREATMENT AND DIAGNOSIS OF PROSTATE CANCER

For CONTINUATION or DIVISION APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 4b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

I. COPY OF PRIOR APPLICATION AS FILED IS ATTACHED

☒ I hereby verify that the attached papers are a true and complete copy of what is shown in my records to be the above-identified prior application, including the oath or declaration as originally filed. (37 CFR § 1.53)

CERTIFICATE OF MAILING
(37 C.F.R. §1.10)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as 'Express Mail Post Office To Addressee' in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

EL199138787US
Express Mail Label No.

July 20, 1999
Date of Deposit

Felicia Reyes
Name of Person Mailing Paper
Felicia Reyes
Signature of Person Mailing Paper

57 Page(s) of Written Description
11 Page(s) of Claims
1 Page(s) of Abstract
11 Sheet(s) of Drawings ☐ formal ☒ informal
2 Page(s) of ☐ Declaration or ☒ Declaration and Power of Attorney
☒ Small Entity Statement

- ☐ Pursuant to 37 § CFR 1.63(d)(1), a newly executed oath or declaration is not required.
- ☒ A copy of the newly corrected executed oath or declaration is filed herewith.
- ☒ A Petition to Make Special is filed herewith.
- ☒ A Statement of Lois Kwasigroch with attachments is filed herewith.
- ☐ I hereby state that the amendment referred to in the declaration filed to complete the prior application, in accordance with the requirements of 37 CFR § 1.53(b), did not introduce new matter therein.

II. AMENDMENTS

- ☐ Cancel in this application original Claims _____ of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)
- ☒ A Preliminary Amendment is enclosed. (Claims added by Amendment must be numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

III. INFORMATION DISCLOSURE STATEMENT

- ☐ An Information Disclosure Statement, PTO 1449 is submitted herewith. (Copies of references were previously submitted in the parent application.)

IV. PETITION FOR SUSPENSION OF PROSECUTION FOR THE TIME TO FILE AN AMENDMENT

- ☐ Filed herewith under separate cover is a petition for suspension of prosecution under 37 CFR § 1.103, together with the fee due under 37 CFR § 1.17 (h).

V. FEE CALCULATION (Calculated after the Preliminary Amendment.)

BASIC FILING FEE:						\$760.00
Total Claims	19	-	20	=	0 x \$18.00	\$0.00
Independent Claims	1	-	3	=	0 x \$78.00	\$0.00
Multiple Dependent Claims	\$260	(if applicable)			<input type="checkbox"/>	\$0.00
TOTAL OF ABOVE CALCULATIONS						\$760.00
Reduction by 1/2 for Filing by Small Entity. Note 37 CFR §§ 1.9, 1.27, 1.28. If applicable, Verified Statement must be attached.						<input checked="" type="checkbox"/> \$380.00
Misc. Filing Fees (Recordation of Assignment)						\$0.00
TOTAL FEES SUBMITTED HERewith						\$380.00

VI. SMALL ENTITY STATUS

A Verified Statement to establish small entity under 37 CFR §§ 1.9 and 1.27:

- ☐ is attached.
- ☒ has been filed in the prior application and such status is still proper and desired. [37 CFR § 1.28(a)]

VII. DRAWINGS

[NOTE: DO NOT CHECK THIS IF PRIOR CASE IS NOT TO BE ABANDONED.]

- ☐ Transfer the drawings from the prior application to this application and, subject to Item 16 below, abandon said prior application as of the filing date accorded to this application. A duplicate copy of this request is enclosed for filing in the prior application file.
[May only be used if signed by (1) applicant, (2) assignee of record or (3) attorney or agent of record and before payment of issue fee. 37 CFR § 1.138.]
- ☐ Transfer the following sheet(s) of drawings from the prior application to this application.
- ☒ New drawings are enclosed ☐ formal ☒ informal

VIII. PRIORITY - 35 USC § 119

- ☐ Priority of application Serial No. _____ filed on _____ in Country is claimed under 35 USC § 119.
- ☐ The certified copy has been filed in prior U.S. application Serial No. _____ on _____.
- ☐ The certified copy will follow.

IX. RELATE BACK - 35 USC § 120

- ☐ Amend the Specification by inserting before the first line the sentence:
This is a continuation of co-pending application Serial No. _____ filed _____, which
will issue as U.S. Patent No. USPatentNo on Issue Date.
- ☒ Relate back information included in preliminary amendment or specification.

X. INVENTORSHIP STATEMENT

- ☒ With respect to the prior co-pending U.S. application from which this application
claims benefit under 35 USC § 120, the inventor(s) in this application is (are):
- ☒ the same
- ☐ less than those named in the prior application and it is requested that the
following inventor(s) identified above for the prior application be deleted:
- [Name(s) of inventor(s) to be deleted]

- ☒ The inventorship for all the claims in this application is:
- ☒ the same.
- ☐ not the same, and an explanation, including the ownership of the various
claims at the time the last claimed invention was made, is submitted.

XI. ASSIGNMENT

- ☒ The prior application is assigned of record to Cornell Research Foundation, Inc.
A copy is attached.
- ☐ An Assignment of the invention to _____ is attached.

XII. FEE PAYMENT BEING MADE AT THIS TIME

- ☐ Not attached. No filing fee is submitted. [This and the surcharge required by 37 CFR
§ 1.16(e) can be paid subsequently.]

☒ Attached.

<input checked="" type="checkbox"/>	Filing fees.	<u>\$380.0</u>
		<u>0</u>
<input type="checkbox"/>	Recording assignment. [\$40.00 37 CFR § 1.21(h)(1)]	—
	Petition fee for filing by other than all the inventors or person on behalf of the inventor where inventor refused to sign or cannot be reached.	
	[\$130.00; 37 CFR §§ 1.47 and 1.17(h)]	
<input type="checkbox"/>	Petition fee to Suspend Prosecution for the Time Necessary to File an Amendment (New Application Filed Concurrently.)	—
	[\$130.00; 37 CFR §§ 1.103 and 1.17(i)]	
<input type="checkbox"/>	For processing an application with a specification in a non-English language.	—
	[\$130.00; 37 CFR §§ 1.52(d) and 1.17(k)]	
<input checked="" type="checkbox"/>	Petition to Make Special.	<u>\$130.0</u>
	[\$130.00]	<u>0</u>
	Total Fees Enclosed	<u>\$510.0</u>
		<u>0</u>

XIII. METHOD OF PAYMENT OF FEES

- ☐ Attached is a check in the amount of _____.
- ☒ Charge Lyon & Lyon's Deposit Account No. **12-2475** in the amount of \$510.00.

XIV. AUTHORIZATION TO CHARGE ADDITIONAL FEES

The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Deposit Account No. **12-2475**:

- ☒ 37 CFR § 1.16(a) (filing fees)
- ☒ 37 CFR § 1.16(b) (presentation of extra claims)
- ☒ 37 CFR § 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)
- ☒ 37 CFR § 1.17 (application processing fees)
- ☐ 37 CFR § 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR § 1.311(b))

XV. INSTRUCTIONS AS TO OVERPAYMENT

- ☒ Credit Lyon & Lyon's Deposit Account No. **12-2475**
☐ Refund check

XVI. POWER OF ATTORNEY

- ☒ The power of attorney in the prior application is to Nixon, Hargrave, Devans & Doyle, LLP.
☐ The power of attorney in the prior application is to the registered attorneys and/or agents listed below and members of or associates in the law firm of **LYON & LYON LLP**, 633 West Fifth Street, 47th Floor, Los Angeles, California 90071, Registration No. 11,611, whose members are registered to practice in the U.S. Patent and Trademark office:

Roland N. Smoot, Reg. No. 18,718
Conrad R. Solum, Jr., Reg. No. 20,467
James W. Geriak, Reg. No. 20,233
Robert M. Taylor, Jr., Reg. No. 19,848
Samuel B. Stone, Reg. No. 19,297
Douglas E. Olson, Reg. No. 22,798
Robert E. Lyon, Reg. No. 24,171
Robert C. Weiss, Reg. No. 24,939
Richard E. Lyon, Jr., Reg. No. 26,300
John D. McConaghy, Reg. No. 26,733
William C. Steffin, Reg. No. 26,811
Coe A. Bloomberg, Reg. No. 26,605
J. Donald McCarthy, Reg. No. 25,119
John M. Benassi, Reg. No. 27,483
James J. Shalek, Reg. No. 29,749
Allan W. Jansen, Reg. No. 29,035
Robert W. Dickerson, Reg. No. 29,914
Roy L. Anderson, Reg. No. 30,240
David B. Murphy, Reg. No. 31,125
James C. Brooks, Reg. No. 29,898
Jeffrey M. Olson, Reg. No. 30,790

Steven D. Hemminger, Reg. No. 30,755
Jerrold B. Reilly, Reg. No. 32,293
Paul H. Meier, Reg. No. 32,274
John A. Rafter, Jr., Reg. No. 31,653
Kenneth H. Ohriner, Reg. No. 31,646
Mary S. Consalvi, Reg. No. 32,212
Lois M. Kwasigroch, Reg. No. 35,579
Lawrence R. LaPorte, Reg. No. 38,948
Robert C. Laurensen, Reg. No. 34,206
Carol A. Schneider, Reg. No. 34,923
Hope E. Melville, Reg. No. 34,874
Michael J. Wise, Reg. No. 34,047
Richard J. Warburg, Reg. No. 32,327
Kurt T. Mulville, Reg. No. 37,194
Theodore S. Maceiko, Reg. No. 35,593
Bruce G. Chapman, Reg. No. 33,846
F. T. Alexandra Mahaney, Reg. No. 37,668
Stephen S. Korniczky, Reg. No. 34,853
James P. Brogan, Reg. No. 35,833
David A. Randall, Reg. No. 37,217
Christopher A. Vanderlaan, Reg. No. 37,747
Reg. No. _____

- ☐ The power appears in the original papers in the prior application.
☐ The power does not appear in the original papers, but was filed on _____ in this application.
☒ A copy of an Associate Power of Attorney has been executed and is attached.
☒ Address all future communications to:

LYON & LYON LLP
633 West Fifth Street, 47th Floor
Los Angeles, California 90071
(213) 489-1600
Attention: Lois M. Kwasigroch, Esq.

XVII. MAINTENANCE OF CO-PENDENCY OF PRIOR APPLICATION

- ☐ A petition, fee and response has been filed to extend the term in the pending **prior** application until _____. A copy of the petition for extension of time in the **prior** application is attached.
- ☐ A conditional petition for extension of time is being filed in the pending **prior** application. A copy of the conditional petition for extension of time in the **prior** application is attached.

XVIII. ABANDONMENT OF PRIOR APPLICATION

- ☐ Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application co-pending with said prior application. At the same time, please add the words "now abandoned" to the amendment of the specification set forth in Item IX above.

Respectfully submitted,

LYON & LYON LLP

Dated: July 20, 1999

By: 

Lois M. Kwasigroch
Reg. No. 35,579

633 West Fifth Street, Suite 4700
Los Angeles, California 90071-2066
(213) 489-1600

Enclosures

Cornell Research Foundation, Inc.
Name of Assignee

20 Thornwood Drive, Suite 105, Ithaca, NY 14850
Address of Assignee

H. Walter Haeussler, President
Title of person authorized to sign on behalf of assignee

Assignment recorded in PTO on September 16, 1997, Reel 8712, Frame 0831



American Type Culture Collection

12301 Parklawn Drive • Rockville, MD 20852 USA • Telephone: (301)251-5570 Telex: 898-055 ATCCNORTH • FAX: 301-770-2587

Docket 242/026
Express Mail
EL199138787US

BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

INTERNATIONAL FORM

RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT ISSUED PURSUANT TO RULE 7.3 AND VIABILITY STATEMENT ISSUED PURSUANT TO RULE 10.2

To: (Name and Address of Depositor or Attorney)

Cornell Medical Center
Attn: Dr. Neil H. Bander or Ms. Lauren Stich
Department of Urology
525 East 68 Street (Box 23, Rm. E-300)
New York, NY 10021

Deposited on Behalf of: Cornell Medical Center

Identification Reference by Depositor:

ATCC Designation

Mouse hybridoma prost J415

HB-12109

The deposit was accompanied by: a scientific description a proposed taxonomic description indicated above.

The deposit was received May 30, 1996 by this International Depository Authority and has been accepted.

AT YOUR REQUEST: ☒ We will inform you of requests for the strain for 30 years.

The strain will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive, or if a U.S. Patent is issued citing the strain, and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strain.

If the culture should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace it with living culture of the same.

The strain will be maintained for a period of at least 30 years from date of deposit, or five years after the most recent request for a sample, whichever is longer. The United States and many other countries are signatory to the Budapest Treaty.

The viability of the culture cited above was tested June 5, 1996. On that date, the culture was viable.

International Depository Authority: American Type Culture Collection, Rockville, Md. 20852 USA

Signature of person having authority to represent ATCC:

Barbara M. Hailey

Barbara M. Hailey, Administrator, Patent Depository

Date: June 5, 1996

cc: ☒ Michael L. Goldman
H. Walter Haessler



American Type Culture Collection

12301 Parklawn Drive • Rockville, MD 20852 USA • Telephone: (301) 331-5520 Telex: 901-764 ATCCROVE • FAX: 301-816-2111

Docket 242/026
Express Mail
EL199138787US

BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF
THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

INTERNATIONAL FORM

RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT ISSUED PURSUANT TO RULE 7.3
AND VIABILITY STATEMENT ISSUED PURSUANT TO RULE 10.2

To: (Name and Address of Depositor or Attorney)

New York Hospital-Cornell Medical Center
Attn: Neil H. Bander, M.D.
Laboratory of Urological Oncology, Rm. E-300 (Box 23)
525 E. 68 Street
New York, NY 10021

Deposited on Behalf of: Dr. Neil H. Bander, Department of Urology, Cornell Medical Center

Identification Reference by Depositor:

ATCC Designation

Mouse hybridoma Prost J591
Mouse hybridoma Prost J533

HB-12126
HB-12127

The deposits were accompanied by: ☐ a scientific description ☐ a proposed taxonomic description indicated above.

The deposits were received June 6, 1996 by this International Depository Authority and have been accepted.

AT YOUR REQUEST:

☒ We will inform you of requests for the strains for 30 years.

The strains will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive, or if a U.S. Patent is issued citing the strains, and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strains.

If the cultures should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace them with living cultures of the same.

The strains will be maintained for a period of at least 30 years from date of deposit, or five years after the most recent request for a sample, whichever is longer. The United States and many other countries are signatory to the Budapest Treaty.

The viability of the cultures cited above was tested June 12, 1996. On that date, the cultures were viable.

International Depository Authority: American Type Culture Collection, Rockville, Md. 20852 USA

Signature of person having authority to represent ATCC:

Barbara M. Hailey
Barbara M. Hailey, Administrator, Patent Depository

Date: June 13, 1996

cc: ☒ Michael L. G. Idman
H. Walter Haeussler



American Type Culture Collection

12301 Parklawn Drive • Rockville, MD 20852 USA • Telephone: (301)231-5520 Telex: 898-055 ATCCNORTH • FAX: 301-770-2517

BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

INTERNATIONAL FORM

RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT ISSUED PURSUANT TO RULE 7.3 AND VIABILITY STATEMENT ISSUED PURSUANT TO RULE 10.2

To: (Name and Address of Depositor or Attorney)

Laboratory of Urological Oncology
Attn: Neil H. Bander, M.D.
Cornell Medical Center - Box 23
1300 York Avenue
New York, NY 10021

Deposited on Behalf of: Cornell University (c/o Dr. Neil H. Bander)

Identification Reference by Depositor:

ATCC Designation

Mouse hybridoma Prost E99

HB-12101

The deposits were accompanied by: ☐ a scientific description ☐ a proposed taxonomic description indicated above.

The deposits were received ☒ by this International Depository Authority and have been accepted.

AT YOUR REQUEST:

☒ We will inform you of requests for the strains for 30 years.

The strains will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive, or if a U.S. Patent is issued citing the strains, and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strains.

If the cultures should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace them with living cultures of the same.

The strains will be maintained for a period of at least 30 years from date of deposit, or five years after the most recent request for a sample, whichever is longer. The United States and many other countries are signatory to the Budapest Treaty.

The viability of the cultures cited above was tested May 7, 1996. On that date, the cultures were viable.

International Depository Authority: American Type Culture Collection, Rockville, Md. 20852 USA

Signature of person having authority to represent ATCC:

Barbara M. Halley

Barbara M. Halley, Administrator, Patent Depository

Date: May 8, 1996

cc: Michael L. Goldman
Lauren S. Stich



Docket 242/026
Express Mail
EL199138787US

AMERICAN TYPE CULTURE COLLECTION
12301 Parklawn Drive
Rockville, MD 20852 USA

Telephone: 301-881-2600

FACSIMILE

Date: May 7, 1996

To: Dr. Neil Bander
Laboratory of Urological Oncology
Cornell Medical Center - Box 23

City & Country: New York, NY

Fax Number: 1-212-746-8941

Total number of pages including this page: One (1)

From: ATCC Patent Depository

ATCC Patent Depository Fax Number: 301-816-4388

Reference: Patent deposit. Mouse Hybridoma Prostate E99 assigned ATCC HB-12101. Date of deposit May 2, 1996. Paperwork will be forwarded to you in a few days.

As instructed, an invoice will be sent under separate cover to the Cornell Research Foundation, Ithaca, NY, as follows:

One time fee - 30 years	\$ 600.00
Informing of Requesters	380.00
Viability test	100.00
Phone/FAX charge	10.00
Total due ATCC HB-12101	\$1,070.00

[Handwritten mark] PLEASE NOTE: The form you have used for this deposit is outdated. Bobbie Brandon retired from the ATCC two years ago. I will be sending you an updated form with your certificate. PLEASE DESTROY ALL OF YOUR OLD FORMS. Thanks.

[Handwritten signature: Barbara Halley]
Barbara Halley - Administrator, Patent Depository
Tel. (301)231-5519

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